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In re Application of : DECISION ON
Long et al :
PCT No.: PCT/US99/15135 :
Application No: 10/018,691 : PETITION UNDER
Int. Filing Date: 02 July 1999 :
Priority Date: 02 July 1998 :
Attorney's Docket No.: 047714-5002-US : 37 CFR 1.47(a) &
For: TAXOL PRODUCTION VIA GENERATION :
OF EXTRACHROMOSOMAL DNAs IN THE : 37 CFR 1.137(b)
FUNGUS PESTALOTIOPSIS :

This is in response to the "RENEWED PETITION FOR FILING AN APPLICATION UNDER 37 CFR §1.47(a) and 37 CFR §1.137(b) with accompanying STATEMENT OF FACTS IN SUPPORT THEREOF" filed on 13 January 2004. Since the decision on 19 August 2003 was mailed to the incorrect address and address change was filed with the USPTO on January 1, 2002, petitioners' petition is viewed as being timely.

BACKGROUND

In a decision from this Office on 19 August 2003, the petition filed on 18 April 2003 was dismissed. The decision indicated first that petitioners had not satisfied requirement 4 under 37 CFR 1.47(a) because a proper executed declaration was not submitted at that time. Second, petitioners had not satisfied requirement 1 under 37 CFR 1.137(b) because a proper reply had not been submitted.

On 13 January 2004, petitioners filed the present renewed petition accompanied, inter alia, a statement of facts in support of petition under 37 CFR 1.47(a), and a proper executed declaration without the signatures of David M. Long.

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

Regarding requirement (4) under 37 CFR 1.47(a), petitioners have provided an executed declaration signed by Mr. Eric D. Smidansky and Gary A. Strobel on their behalf and on the behalf of the nonsigning joint inventor David M. Long.

Petitioners have now satisfied items (1), (2), (3), and (4) under 37 CFR 1.47(a), thus completing the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

PETITION UNDER 37 CFR 1.137(b):

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

With respect to requirement (1), petitioners have not provided the proper reply because no "Sequence Listing" has been submitted with the current petition that was requested in the Notification of Missing Requirements mailed on 20 March 2002. Although, petitioners have provided a copy of the date-stamped postcard receipt indicating a copy of the Sequence Listing and the diskette containing Sequence Listing was submitted on that date, no diskette containing the Sequence Listing is in the file. Therefore, a true copy of the sequence-related materials on the diskette submitted on 18 April 2003 is requested to complete filing the proper reply under 37 CFR 1.137(b).

Consequently, the petition is deemed to not to satisfy requirement (1) under 37 CFR 1.137(b).


DECISION


The petition under 37 CFR 1.47(a) is **GRANTED**.

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.137(b) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Failure to timely submit the proper reply will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.137(b)." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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